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EXAMINER

GREGORY, BERNARR E

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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1. This Office Action is in response to the Response of 13 June 2009.
2. It is noted in the Response that Applicant has stated in the fourth paragraph on page 2 of that communication that there is "no legal basis for the '112 rejection." This statement does not seem to agree with the written record in that the official Office Action of 17 March 2009 presents the legal basis of the rejection in section 2 on page 2 of the official Office Action. Namely, the legal basis of the rejection is 35 USC 112, first paragraph.
3. In paragraphs 5 and 6 on page 2 of Applicant's Response, there is reference to a telephonic inquiry by Applicant's attorney as to the legal basis for the rejection of record in this application. The characterization of the communication is not considered accurate. The telephonic inquiry by Applicant's attorney to the examiner to inquire as to the legal basis of the rejection was not understood by the examiner in that the Applicant's attorney was presumably in possession of the official Office Action of 13 June 2009, which states plainly what the legal basis for the rejection is. It is noted that according to 37 CFR 1.2 the business of the United States Patent and Trademark Office is conducted in writing. The allegations of what was said verbally in the telephonic communication of 11 June 2009 are given no weight.
4. As for the seventh paragraph on page 2 of Applicant's Response, Applicant's attorney has set forth some ipse dixit as to how the USPTO is allegedly run. It would appear that Applicant's attorney is of the impression that rejections are made according

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to the MPEP. He is reminded that as an administrative agency, the USPTO applies rejections and objection according to Title 37 of the Code of Federal Regulations and Title 35 of the United States Code. The Manual of Patent Examining Procedure is offered to examiners as an aid. It is not law, and it is not the basis on which arguments may be made to satisfy Applicant's burden under 37 CFR 1.111(b).

5. On page 3 of Applicant's Response it is argued that the rejection of record under 35 USC 112, first paragraph, fails to state that the making and using of the invention would require "undue experimentation," quoting a section of MPEP 2164.04. However, Applicant has failed to note the portion of the quoted passage after the words, "undue experimentation." Please note the words, "or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims." Per this cited paragraph, undue experimentation need not be alleged.

6. On the lower portion of page 3 of Applicant's Response, it is argued that the rejection of record does not consider the claims as a whole, but focuses merely on the "converter." In response, it is noted that in order for a claim to be enabled, it must be totally enabled. Thus, even if one of the rejected claims were enabled for everything except for the "converter," the lack of enablement for the "converter" causes enablement for the claim as a whole to fail. The cited paragraph from MPEP 2164.08 is not seen to contain anything to call into question the rejection of record.

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7. On page 4 of Applicant's Response, there is an allegation that the inquiry into what range of wavelengths are useable is "not important to the '112 rejection" (first full paragraph on page 4 of the Response). The inquiry is important is that it shows that there is not disclosure to support "the scope of protection sought by the claims" (from the passage of MPEP 2164.04 cited by Applicant on page 3 of the Response).

8. Finally, it is pointed out that since Applicant has not distinctly and specifically argued each objection and rejection in the outstanding Office Action, Applicant is not entitled to further consideration. Applicant has argued neither the objection to the Specification under 37 CFR 1.71 nor the actual rejection under 35 USC 112, first paragraph. The arguments using the MPEP do not meet Applicant's burden under 37 CFR 1.111(b). Therefore, the objection and rejection of record are hereby maintained. If Applicant does not seek protection outside of the range of wavelengths disclosed, then there must be amendment or remarks for estoppel.

9. The Specification is hereby objected to under 37 CFR 1.71 in that fails to teach one of ordinary skill-in-the-art how to make and/or to use the invention.

Throughout claims 1-84, the claimed apparatus and method are claimed as employing "electromagnetic energy"; however, in the Specification, the range of wavelengths of electromagnetic energy used is very limited. For example, on page 6, line 34 of the Specification, the wavelength of energy discussed is 1.064  $\mu\text{m}$ . Further, on page 9, line 16 of the Specification, the wavelengths discussed

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are those in the range 1.06-1.07  $\mu\text{m}$ . It is further noted that the structure used to convert the electromagnetic energy to “electrical power” is disclosed as the solar cell (e.g., see page 6, line 35 through page 7, line 1). Thus, there is no disclosure for the use of all or even a large portion of the EM spectrum in the invention. Please note that solar cells are very limited in what range of EM wavelengths that they may use to produce electricity. For example, EM waves such as X-rays and  $\gamma$ -rays could not be used with the invention as disclosed.

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-84 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for EM wavelengths usable by solar cells, does not reasonably provide enablement for EM wavelengths outside of the range usable by solar cells. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or to use the invention commensurate in scope with these claims. Please see the remarks in the objection to the Specification in section 9 above.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernarr E. Gregory whose telephone number is (571) 272-6972. The examiner can normally be reached on weekdays from 6:30 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas H. Tarcza, can be reached on (571) 272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Bernarr E. Gregory/  
Primary Examiner, Art Unit 3662